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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,660	12/08/2000	Haruhiko Kouhara	038602/1023	1711

7590 05/14/2003  
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Washington, DC 20007-5109

EXAMINER
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HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 05/14/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n N .

09/731,660

Applicant(s)

KOUHARA ET AL.

Examin r

Richard G Hutson

Art Unit

1652

--The MAILING DATE f this communication appears on th cover sheet with the corresp ndenc address --

THE REPLY FILED 24 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.


Claim(s) rejected: 2, 4-6, 11-13.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.

10. ☐ Other: \_\_\_\_\_

  
RICHARD HUTSON, PH.D.  
PATENT EXAMINER

Continuation of 2. NOTE: Applicants proposed amendment adding new claim 22 would require further consideration and or search. Specifically applicants reference to a nucleic acid probe that encodes at least 100 contiguous amino acids of SEQ ID NO: 1, has not previously been considered and would require additional search.

Continuation of 5. does NOT place the application in condition for allowance because: The rejections of record in light of the non-entry of applicants amendment.

#### Claim Objections

Claims 1, 2, 4-6 and 11-13 remain objected to because of the following informalities:

Claims 1, 2, 4-6 and 11-13 each recite "FRS2 polypeptide" or depend from a claim which recites "FRS2 polypeptide". It is suggested that the first time in the claims the term "FRS2 polypeptide" is used it be written out in full, followed by the abbreviation in parenthesis.

Applicants proposed amendment if entered would overcome this objection.

#### Claim Rejections - 35 USC § 112

Claims 2, 4-6 and 11-13 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection is stated in the previous office action. Applicants proposed amendment and argument if entered would not overcome this rejection because it remains unclear what is encompassed by "FRS2 activity".

Claims 2, 4-6 and 11-13 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection is stated in the previous office action. Applicants amendment and argument of this rejection if entered would not overcome this rejection. If entered applicants proposed amendment of claim 4, such that the structural limits are drawn to the nucleic acid probe itself, rather than the target molecule, would not overcome the rejection of record because the genus of molecules that is claimed remain inadequately described by virtue of the minor structural limitations of the claimed nucleic acid molecules/ probes (claim 4 would limit the claimed probe to a mere 30 nucleotides of SEQ ID NO: 1 which is greater than 1500 nucleotides). With respect to claim 11, applicants attention is directed to part (h) which in a similar fashion as part (d) reads on any nucleic acid.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov).

Claims 2, 4-6 and 11-13 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid encoding a FRS2 polypeptide, wherein said FRS2 polypeptide has the amino acid sequence of SEQ ID NO: 1, does not reasonably provide enablement for any nucleic acid encoding any FRS2 polypeptide. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The rejection is stated in the previous office action. As above in the rejection under 112 first paragraph for a lack of written description applicants argument, is not found persuasive for the same reasons as above and if entered would not overcome this rejection.

#### Claim Rejections - 35 USC § 102

Claims 4 and 11 remain rejected under 35 U.S.C. 102(b) as being anticipated by Otilie et al. (Oncogene Vol 7, No 8: 1625-1630, August 1992).

The rejection is stated in the previous office action. This rejection remains based on the non-entry of applicants amendment.

#### Claim Rejections - 35 USC § 103

Claims 2, 4-6 and 11-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (Oncogene, Vol 13, pages 721-729, 1996).

The rejection is stated in the previous office action. This rejection remains based on the non-entry of applicants amendment.